

**Applicant: David A. Esposito**  
**Application No.: 10/672,590**

### Remarks

#### ***Status***

Claims 17-36 were pending in the application. The Examiner withdrew claims 17-27 and 32 as directed to an apparatus invention. Also, the Examiner rejected claims 28-31 and 33-36 for the reasons defined in the Office Action and summarized below. Claim 32 has been amended to correct a typographical error in that the first "game" word should have been "method" instead. Accordingly, claim 32, as amended, is clearly a method claim and should be grouped in with claims 28-36. Applying the Examiner's logic, only claims 17-27 should be withdrawn as directed to another invention. In addition, claim 34 was amended to remove duplicative language. As the amendments to both claims 32 and 34 are editorial the amendments should clearly be entered.

#### ***Discussion***

The undersigned Applicant's attorney thanks the Examiner for the April 26, 2005 telephone conference.

The Examiner withdrew claims 17-27 and 32 as directed to an apparatus invention. As mentioned above, Applicant has now corrected a typographical error in claim 32 that should clarify that claim 32 is a method claim along with claims 28-31 and 33-36.

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Applicant traverses the Examiner's restriction of claims 17-27 as directed to a separate invention. No further search would be needed to evaluate claims 17-27 and, therefore, said claims should not be the subject of the restriction.

The Examiner rejected claims 28-31 and 33-36 (and presumably also would reject amended claim 32) under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,375,846 to Smith in view of U.S. Patent No. 5,882,008 to Siegesmund, both of which were newly cited by the Examiner.

Applicant traverses this rejection because Smith does not disclose or suggest Applicant's invention as recited in the claims. Smith discloses a sexual etiquette game in which, after all the cards have been dealt and played, the players rate themselves and each other on perceived sexual sensitivity. See Smith Abstract.

In the Applicant's game, only the "player-in-turn" is scored. Also, the scoring is done by the other players, not the player-in-turn himself. See Applicant's independent claims 28 and 33.

The scoring in Applicant's game is performed during each turn as the game is played.

Another difference between Smith and the Applicant's invention is that Smith is simply a card game while Applicant's claims also include a path. Claim 32 discloses the path being in the form of a game board. As stated in claim 28 in the Application, "a player-in-turn is provided with a hypothetical real life scenario

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based on their position on the path."

Smith clearly has no path for the players to traverse, as the Smith game simply entails dealing cards. As there is no path, a player in the Smith game cannot be provided with a hypothetical scenario based on the player's position on the path.

The Examiner claims that it would be obvious to have included a game board (and path) to the Smith game. It should be noted that the motivation provided by the Examiner was from the background of the Smith patent and not anything pertaining to the Smith sexual etiquette game. There is no suggestion in the Smith patent that a game board could be utilized to play the card game.

The Examiner included the Siegesmund patent in this rejection but did not apply the reference in his rejection. While the Siegesmund patent may disclose a game board it has no suggestion that a game board could be used in the Smith sexual etiquette game. Therefore, there is no suggestion to combine Smith and Siegesmund.

The applicant submits that the Examiner is reconstructing the prior art with the hindsight of the claimed invention in violation of 35 U.S.C §103. The Smith game no more requires a path or game board than would be required by other card games such as poker, for example.

Smith also does not disclose at least two other features of Applicant's invention. The subject matter of Smith is limited to sexual etiquette. Applicant's invention pertains to non-sexual situations, e.g., situations encountered by parents,

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children and workers. See claim 22.

Furthermore, in Smith, the players are scoring each other's answers based on the perceived sexual sensitivity shown in the answer. In Applicant's game, the players are not scoring the player-in-turn's answer to the question, but rather are scoring the player-in-turn's analysis and reasoning used to reach the answer. In other words, in Smith the answer is scored, in Applicant's game analysis and reasoning are scored.

For at least the reasons advanced above it is submitted that independent claims 28 and 33 are patentable over the cited references. Accordingly, claims 29-32 and 34-36 that depend therefrom are submitted to be patentable for at least the reasons discussed above with respect to claims 28 and 33 and for the further features recited therein. The rejections should, therefore, be withdrawn.

As stated above, it is Applicant's position that claims 17-27, the "apparatus" claims, are not a separate invention from claims 28-36 and should not be withdrawn as restricted. Furthermore, for the reasons stated above (and for the further features recited therein), claims 17-27 also are patentable over the cited references.

Applicant will file a signed Revocation of Power of Attorney/Power of Attorney form, similar to the attached form, within the next few days. Since time is of the essence in this After Final situation, Applicant requests that any future papers be sent directly to Applicant's attorney at the address indicated below.

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***Conclusion***

For the foregoing reasons, Applicant respectfully submits that claims 17-36 are in condition for allowance. Accordingly, early allowance of claims 17-36 is earnestly solicited.

As mentioned the April 26, 2005 telephone conference, the undersigned would welcome the opportunity to further discuss this case with the Examiner if so desired by the Examiner.

Respectfully submitted,

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